



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/391,869 09/08/99 SMITH

M 83317/00004

023387 QM12/0928
HARTER SECREST & EMERY, LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER NY 14604-2711

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722
DATE MAILED:

09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/391,869

Applicant(s)
Mary Smith

Examiner
Mark T. Henderson

Art Unit
3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 27, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 8, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 20) ☐ Other: _____

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Continued Prosecution Application

1. The request filed on June 27, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/391,869 is acceptable and a CPA has been established. An action on the CPA follows.

Art Unit: 3722

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25 and 32-35, are drawn to a pocket insert assembly, classified in class 281, subclass 31.
- II. Claims 26-31, are drawn to a method of binding a book(s), classified in class 270, subclass 287.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as assembling the pages individually.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney Brian Shaw on September 21, 2001 a provisional election was made with traverse to prosecute the invention of Group 1, claims 1-25 and 32-35. Affirmation of this election must be made by applicant in replying to this Office

Art Unit: 3722

action. Claims 26-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "37" has been used to designate both an "edge" and an "adhesive strip", as stated on page 6 of the specification. Correction is required.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a second edge of the base sheet, wherein "at least a portion of the second edge being unattached to the base sheet" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3722

7. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation "the pocket sheets" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Michlin (5,141,252).

Michlin discloses in Fig. 1-3, a pocket insert capable of passing through a printer (Col. 3, lines 15-18) comprising a base sheet (16) with a thickness and a binding edge (between 19 and 15), a pocket sheet (17) having the same thickness as that of the base sheet (Col. 2, lines 40-46), an adhesive or securing means between the base sheet and the pocket sheet to form a pocket with an opening (C) facing the binding edge, and wherein the pocket insert has a maximum thickness

Art Unit: 3722

equal to a combined thickness of the single thickness (from base sheet), the single sheet thickness (pocket sheet) and the adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-18, 22-25 and 32-34, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (5,042,841) in view of Dick (1,495,953).

Friedman discloses in Fig. 1, a book having multiple pages (not shown, but stated in the abstract) and a pocket insert (10) to hold multipage materials comprising a base sheet (14) of paper material having a binding edge (24), a planar first surface (14A), a planar second surface (14B); a pocket sheet (12) having a planar inner surface (12A), a planar outer surface (12B), a width smaller than the width of the base sheet, a perimeter defined by an attached edge section (16, 18, 20) and a free edge section (22), wherein at least a portion of the attached edge section is adhered to the base sheet (14) and the free edge section being (22) being unattached to the base sheet to form a pocket (B); wherein the base sheet (14) and the pocket sheet (12) are arranged

Art Unit: 3722

such that the pocket opening faces and is parallel to the binding; a first edge (18) attached to the base sheet, a second edge (24), a third edge (16) and an opposed fourth edge (20); and wherein the base sheet and pocket are formed on a single section of paper material and folded along a fold line (18).

However Friedman does not disclose a perimeter defined by an attached edge section on the inner surface, wherein the attached edge section being adhered to the first surface of the base sheet along a plurality of seams.

Dick discloses in Fig. 1, a pocket insert made of any desirable material (Col. 2, lines 85-90) having a perimeter defined by an attached edge section (5) on an inner surface (4A), wherein the attached edge section is adhered to the first surface (1A) of the base sheet (1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Friedman's pocket insert to include a pocket sheet having an attached section to the first surface of the base sheet as taught by Dick for the purpose of providing a reinforced edge.

In regards to **Claim 4, 16, 17, 18, 25, 32, 33**, it would have been an obvious matter of design choice to construct the pocket sheet width in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Art Unit: 3722

In regards to **Claim 5, 7, 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the base sheet and pocket sheet, and base sheet and second edge being separate sheet, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regards to **Claims 10, 14, 15, 24**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form as many pockets as desired on the insert, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

11. Claims 19-21, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Dick in further view of Snow (Des. 363,737).

Friedman as modified by Dick discloses a book with a pocket insert comprising all the elements as claimed in Claim 1 and as set forth above. However, Friedman does not disclose a book comprising a front and back cover, wherein the pages and insert are disposed between the covers.

Snow discloses in Fig. 1 a book (A) comprising a front cover (B) and a back cover (C), wherein pages and inserts can be retained.

Art Unit: 3722

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Friedman's book to have a front and back cover as taught by Snow for the purpose of protecting the insert and pages.

Response to Arguments

12. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 25, 2001



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700